

## **REMARKS**

### **I. INTRODUCTORY REMARKS**

Claims 1-7, 11, 13, and 35-50 are pending in the application. By this Amendment, claims 6, 38, 40, 43, 46, and 49 are hereby amended to more particularly define the recited "tax data provider." Claims 8, 9, 10, 12, and 14-34 were canceled previously. In view of the foregoing amendments and following remarks, the Applicant respectfully requests reconsideration of the application and submits that the application is in condition for allowance. A notice indicating the same is respectfully solicited.

### **II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

In numbered paragraphs 4-5 on pages 10-13 of the Office Action dated September 22, 2006, claims 1, 2, 4-7, 11, 13, and 35-50 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,473,741 to Baker. The rejection is respectfully traversed. By this Amendment, claims 6, 38, 40, 43, 46, and 49 are amended to more particularly define the recited "tax data provider." Accordingly, in view of the foregoing amendments and following remarks, it is respectfully submitted that Baker fails to anticipate at least claims 1, 11, 13, 42, 45, and 48 as well as at least claims 6, 38, 40, 43, 46, and 49. Claims 2-5, 7, 35-37, 39, 41, 44, 47, and 50 depend variously from claims 1, 11, 13, 42, 45, and 48 and are submitted as being allowable for at least the same reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); *see* M.P.E.P § 2131. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

#### **A. Claims 1, 2, 4-7, 11, 13 and 35-50**

Here, claim 1 recites:

A method for collecting tax information by a tax information requestor comprising the steps of:  
connecting electronically said tax information requestor to an electronic intermediary;

collecting electronically at least one of an electronic tax return or tax data of a taxpayer from said electronic intermediary, *wherein said electronic tax return and/or tax data is electronically provided to said electronic intermediary by a tax data provider*; and

performing a check of said taxpayer by said tax information requestor using said electronic tax return or tax data collected electronically,

wherein said check is not used to compute taxes of said taxpayer, wherein said tax information requestor is not a taxing authority, and wherein said electronic intermediary stores said electronic tax return or tax data. (emphasis added).

Thus, claim 1 requires that the electronic tax return and/or tax data collected electronically from the electronic intermediary is electronically provided to the electronic intermediary by a **tax data provider**. The instant disclosure defines the term “tax data provider” as “each party that has tax information relevant to the taxpayer’s tax liability or tax reporting obligations.” Page 9, lines 21-22. “Non-limiting examples of tax data providers include the taxpayer’s employers 22, partnerships, banks 23, savings and loans institutions, mortgage institutions, credit card bureaus, thrift institutions, security brokerage firms 24, mutual fund holding institutions, charities 25, and federal, state, local, and foreign taxing authorities 27.” Page 9, line 21 – page 10, line 3 of the instant disclosure.

Baker, on the other hand, purportedly teaches a method and system for aggregation and exchange of electronic tax information for marketing purposes, wherein the tax information is provided by individual accounting and tax preparation firms and is warehoused at a central location for access by 3<sup>rd</sup> party requestors. *See e.g.*, column 1, lines 15-19; column 10, line 56 – column 11, line 20. Importantly, the tax information described in the method and system of Baker is provided by **individual accounting and tax preparation firms** to the central location (e.g., a service bureau 20). *Id.* In rejecting claim 1, therefore, the Office Action ostensibly aligns Baker’s “individual accounting and tax preparation firms” with the recited “tax data providers.” *See, e.g.*, Office Action, page 3, lines 16-18. It is respectfully submitted that the “individual accounting and tax preparation firms” described in Baker are not “tax data providers” under the definition provided in the present application. Furthermore, Baker’s “individual accounting and tax preparation firms” do not fall within the scope of the specifically enumerated types of “tax data providers.”

As set forth in the Background Section of the instant disclosure (for example, page 5, lines 6-8), tax information is usually stored, manually accessed, and manually duplicated by a respective taxpayer who then provides the tax information to a tax information requestor upon request. This, unfortunately, allows the possibility that such tax information may be altered by the taxpayer or inaccurate when provided to the tax information requestor. Therefore, the recitation in claim 1 requiring that a tax data provider electronically provide the tax information (i.e., the electronic tax return and/or the tax data) to the electronic intermediary helps to ensure that the tax information is accurate and unaltered. The tax information described in the method and system of Baker is provided by *individual accounting and tax preparation firms* to the central location (e.g., a service bureau 20) and, thus, inevitably faces problems similar to the known prior art discussed in the background section of the instant application. *See also* Amendment submitted June 29, 2006, pages 10-12. That is, the tax information provided to a 3<sup>rd</sup> party requestor by the centralized service bureau 20 in Baker is susceptible to alteration and inaccuracies because such tax information was originally submitted by the respective taxpayer to the aforementioned individual accounting and tax preparation firms. For example, a taxpayer could, theoretically, inflate his or her salary, or taxable income, and instruct his or her accountant to file a return based thereon. Alternatively, the taxpayer could instruct the accountant to file a tax return and subsequently file an amended return without consulting the accountant. In either case, therefore, the tax information held by the individual accounting and tax preparation firm, and transmitted to the service bureau, may be incorrect. Although Baker notes that “[i]ndividual firm databases are more reliable . . . than IRS or other agency computers” (column 6, lines 16-18) and that “lenders and other interested 3<sup>rd</sup> parties have *some* assurance that information received directly from a professional tax preparer has not been altered in a fraudulent manner” (column 5, lines 60-63 (emphasis added)), the system and method described in Baker cannot guarantee the quality and accuracy of the information.

As noted above with regard to claim 1 of the instant application, however, the recited tax information does not derive from the taxpayer, but rather from *tax data providers* which are the very source of the tax information. *See, e.g.*, page 9, line 22 through page 10, line 3 of the instant disclosure. Such tax data providers are generally subject to IRS penalties if they incorrectly report taxpayer tax information. Thus, because the tax information is not originally prepared and/or submitted by the taxpayer but is, instead, prepared and/or submitted by third

party tax data providers with independent reasons for assuring the veracity of the tax information, such tax information is inherently more reliable. Accordingly, the “individual accounting and tax preparation firms” described in Baker are not “tax data providers.”

Moreover, claim 6, as amended, further recites:

***said tax data provider being said taxpayer’s employer, said taxpayer’s partnership, said taxpayer’s bank, said taxpayer’s savings and loan institution, said taxpayer’s mortgage institution, said taxpayer’s credit card bureau, said taxpayer’s thrift institution, said taxpayer’s securities brokerage firm, said taxpayer’s mutual fund holding institution, said taxpayer’s charity, the Internal Revenue Service, or a taxing authority.***  
(emphasis added).

Thus, claim 6 includes a positive recitation of the specific types of tax data providers from which said electronic tax return and/or tax data is electronically provided to said electronic intermediary. Specifically, the tax data provider is recited as “being said taxpayer’s employer, said taxpayer’s partnership, said taxpayer’s bank, said taxpayer’s savings and loan institution, said taxpayer’s mortgage institution, said taxpayer’s credit card bureau, said taxpayer’s thrift institution, said taxpayer’s securities brokerage firm, said taxpayer’s mutual fund holding institution, said taxpayer’s charity, the Internal Revenue Service, or a taxing authority.” *See also* page 9, line 21 – page 10, line 3 of the instant disclosure. Further to the argument presented above with respect to claim 1, it is respectfully submitted that the “individual accounting and tax preparation firms” suggested in Baker are not “tax data providers” and, moreover, do not fall within the scope of any of the specifically enumerated types of tax data providers recited in at least claim 6. That is, Baker’s “*individual accounting and tax preparation firms*” are not “*said taxpayer’s employer, said taxpayer’s partnership, said taxpayer’s bank, said taxpayer’s savings and loan institution, said taxpayer’s mortgage institution, said taxpayer’s credit card bureau, said taxpayer’s thrift institution, said taxpayer’s securities brokerage firm, said taxpayer’s mutual fund holding institution, said taxpayer’s charity, the Internal Revenue Service, or a taxing authority.*” *But cf.* Office Action, page 6, lines 10-21; page 12, line 13 – page 13, line 2; page 16, lines 10-21 (arguing that Baker’s “individual accounting and tax preparation firms” are broadly interpreted to be “employers”).

In view of the foregoing, claim 1 is respectfully submitted as being allowable. Furthermore, claim 6 is also submitted as being allowable. Reconsideration and withdrawal of

the rejection are respectfully requested. Claims 2, 4, 5, 7, and 35 depend from claim 1 and are submitted as being allowable over Baker for at least the same reasons. Claims 11 and 13 include recitations similar to that of claim 1. Claims 36 and 39 depend from claim 11 and are submitted as being allowable over Baker for at least the same reasons. Claims 37 and 41 depend from claim 13 and are submitted as being allowable over Baker for at least the same reasons. Claims 38 and 40 depend from claims 11 and 13, respectively, and include recitations similar to that of claim 6.

Claims 42, 45, and 48 recite features similar to that in claims 1, 11, and 13, except that the tax information requestor connects directly electronically to, and collects directly electronically from, the tax data provider rather than indirectly through an electronic intermediary as recited in claims 1, 11, and 13. Claims 44, 47, and 50 depend from claims 42, 45, and 48, respectively, and are submitted as being allowable over Baker for at least the same reasons. Claims 43, 46, and 49 depend from claims 42, 45, and 48, respectively, and include recitations similar to that of claim 6. Reconsideration and withdrawal of the rejections are respectfully requested.

**B. Response to Arguments**

Notwithstanding the foregoing deficiencies in Baker regarding at least claims 1 and 6, the Office Action continues to maintain several untenable positions that appear to disregard well-understood principles of current U.S. patent law. The various claim interpretation arguments presented throughout the Office Action are respectfully traversed or rendered moot for at least the following six reasons.

First, in response to the arguments presented at page 3, line 1 – page 4, line 6 of the Office Action, the Applicant respectfully reiterates the arguments presented above in Section II(A), at pages 10-12. That is, it is respectfully submitted that the “individual accounting and tax preparation firms” described in Baker are not “tax data providers” under the definition provided in the present application. Furthermore, Baker’s “individual accounting and tax preparation firms” do not fall within the scope of the specifically enumerated types of “tax data providers.” Furthermore, with regard to the arguments presented at page 13, lines 6-20 of the Office Action, the Applicant respectfully submits that the Examiner’s interpretation of Baker’s “individual accounting and tax preparation firms” as being “tax data providers,” and more specifically,

“employers,” is without merit and, in any event, moot, based on the amended recitation in claim 6 of “said taxpayer’s employer.”

Second, the Office Action improperly disregards various features/steps/entities positively recited in the claims. For example, the Office Action states that “the recited structure and functionality are not affected by who or what performs each step of the claimed invention” (page 4, lines 16-17), and further states that “[a]s far as the scope of the invention is concerned, whether a taxpayer, a tax preparer, an employer, . . . or a taxing authority provides the recited tax data, the recited steps are performed the same” (page 4, line 18 – page 5, line 1). *See also* Office Action, page 6, lines 6-10; page 9, lines 20-21; page 12, lines 9-13; page 16, lines 6-10.

On the contrary, the Applicant respectfully submits that each feature and/or specifically defined entity recited in a claim imparts some functionality to the claim and must be afforded patentable weight. As pointed out above, claim 1 recites, *inter alia*, the step of:

collecting electronically at least one of an electronic tax return or tax data of a taxpayer from said electronic intermediary, ***wherein said electronic tax return and/or tax data is electronically provided to said electronic intermediary by a tax data provider*** (emphasis added).

Claim 6, for example, further recites:

***said tax data provider being said taxpayer’s employer, said taxpayer’s partnership, said taxpayer’s bank, said taxpayer’s savings and loan institution, said taxpayer’s mortgage institution, said taxpayer’s credit card bureau, said taxpayer’s thrift institution, said taxpayer’s securities brokerage firm, said taxpayer’s mutual fund holding institution, said taxpayer’s charity, the Internal Revenue Service, or a taxing authority.*** (emphasis added).

The highlighted portions of the above-captioned clauses are positive recitations that said electronic tax return and/or tax data is electronically provided to said electronic intermediary by a tax data provider, specifically at least one of the listed tax data providers and therefore, does, in fact, “affect the structure and functionality of the claimed invention.” For example, assuming claim 1 was an enforceable claim in a valid issued patent, a potential infringer that performed the step of collecting electronically an electronic tax return and/or tax data of a taxpayer from an electronic intermediary would not infringe claim 1 if, for instance, the electronically collected electronic tax return or tax data was not electronically provided to the electronic intermediary by

a tax data provider, as defined in the instant application. Likewise, a potential infringer that performed the step of collecting electronically an electronic tax return and/or tax data of a taxpayer from an electronic intermediary would not infringe claim 6 if, for instance, the electronically collected electronic tax return or tax data was not electronically provided to the electronic intermediary by one of the listed types of tax data providers. In this way, the recitation of a “tax data provider” in at least claim 1 and the recitation of the specific types of tax data providers recited in at least claim 6 do, in fact, “affect the structure and functionality of the claimed invention,” contrary to the assertions made in the Office Action.

Third, and further to the second reason discussed above, the Applicant respectfully reiterates that the term “tax data provider” in at least claim 1 and/or the specific types of tax data providers recited in at least claim 6 are not merely non-functional descriptive material, nor do such recitations lend themselves to an analogous interpretation. *See* Amendment filed June 29, 2006, pages 12-13. The Office, however, is apparently not persuaded by this argument and ostensibly asserts that the recitation of a specifically defined entity (or entities) in the claims is akin to a recitation of non-functional descriptive material, thus warranting no patentable weight. *See, e.g.*, Office Action, page 5, line 16 (“the same analysis is relevant in both situations”); *see also* page 7, lines 6-7 and page 15, lines 4-5 (“the specific recited examples of a tax data provider amount to merely non-functional, descriptive material”); *see generally* page 5, line 14 – page 6, line 5. This reasoning is respectfully traversed.

As noted above, claim 1 recites that “said electronic tax return and/or tax data is electronically provided to said electronic intermediary by a tax data provider” and claim 6 further defines the tax data provider as “being said taxpayer’s employer, said taxpayer’s partnership, said taxpayer’s bank, said taxpayer’s savings and loan institution, said taxpayer’s mortgage institution, said taxpayer’s credit card bureau, said taxpayer’s thrift institution, said taxpayer’s securities brokerage firm, said taxpayer’s mutual fund holding institution, said taxpayer’s charity, the Internal Revenue Service, or a taxing authority.” The Office’s interpretation of a positively recited entity capable of providing tax information (i.e., the tax data provider) as constituting, or being analogous to, “descriptive material” (*see e.g.*, page 5, line 14 – page 6, line 5) demonstrates a complete misunderstanding of the legal guidelines regarding identifying descriptive material and the interpretation thereof. M.P.E.P. § 2106(IV)(B)(1), for example, states:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of ***data structures and computer programs*** which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to ***music, literary works and a compilation or mere arrangement of data***. (emphasis added).

The foregoing definitions of the types of descriptive material, thus, provide guidance to Examiners in determining whether or not particular **data structures** recited in computer-related claims are statutory subject matter. Furthermore, for purposes of determining compliance with 35 U.S.C. §§ 102 and 103, M.P.E.P. § 2106(VI) states:

If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described supra in paragraphs IV.B.1(a) and IV.B.1(b).

Both of the foregoing determinations are *clearly irrelevant* in terms of interpreting the term "tax data provider" and/or the specifically recited types of tax data providers. Within the context of the disclosed embodiments of the present application, such tax data providers are actual entities or parties capable of providing tax information and whose positive recitation in the claims "affect[s] the structure and functionality of the claimed invention." Accordingly, the Applicant respectfully submits that the Office's interpretation of the term "tax data provider" and/or the specifically recited types of tax data providers as being non-functional descriptive material is without merit.

Fourth, throughout the various arguments presented in the Office Action, the term "user" is repeatedly discussed, especially in the context of addressing the weight given to the recitations of the "tax data provider" and/or the specifically recited types of tax data providers. For example, at page 4, lines 16-17, the Office Action states that "the recited structure and functionality are not affected by who or what performs each step of the claimed invention" and "there are no structural elements that verify the identify of a *user*." The Office Action also states



“the same structural elements are used regardless of the specific *user* of the invention” (page 5, lines 1-2) and “a human *user* cannot be recited as a system element; therefore the type of *user* using a system does not patentably distinguish the invention, especially the system/apparatus claims, over the prior art” (page 5, lines 4-6). Additionally, the Office Action states that “[s]ince the type of *user* providing data does not affect the recited structure or functionality, the type of *user* serves as a mere label for a *user*” and “at best, the type of *user* submitting tax data implies a type of tax data that the specific *user* type typically has access to.” Page 5, lines 16-20.

In response, the Applicant initially points out that no “user” is recited in any of the pending claims and, accordingly, many of the statements and arguments are difficult to understand and believed to be irrelevant. Assuming, however, that the Office Action is simply referring to the tax data providers (i.e., the positively recited entities) in some general manner as “users,” the Applicant respectfully reiterates the arguments presented above that the recited tax data providers bear on “the structure and functionality of the claimed invention” by defining a set of entities that perform an express function. Such a recitation gives scope and meaning to the claims, and must be accorded patentable weight. Moreover, the recited tax data providers are not necessarily “users of the invention.” See Office Action, page 5, lines 1-2.

Fifth, the Applicant respectfully submits that the Office’s interpretation of the individual accounting and tax preparation firms described in Baker as possibly being considered a “taxing authority” (see Office Action, page 7, lines 5-6 and page 15, lines 2-3), is improper. The term “taxing authority” is explicitly defined in the instant disclosure as being “the IRS, or a state, local, or foreign taxing authority.” See, e.g., page 14, lines 9-10 of the instant disclosure. For example, it is this “taxing authority” with which tax returns are filed by taxpayers. See, e.g., page 14, lines 6-10 of the instant disclosure. Likewise, it is this “taxing authority” to which taxes are owed or from which a tax refund is due. See, e.g., page 14, lines 11-14 of the instant disclosure. Accordingly, the individual accounting and tax preparation firms described in Baker are not “taxing authorities” and it would not have been obvious to one having ordinary skill in the art to modify the method and system of Baker such that the tax information is electronically provided by the specific types of tax data providers including, for example, a “taxing authority,” rather than by the disclosed individual accounting and tax preparation firms.

Sixth, the Applicant respectfully submits that the Office’s interpretation of the recited “tax information requestor” and “tax data provider” as being “relative” terms (see page 13, lines

12-13) that are met by either of the various entities disclosed in Baker is moot. That is, neither one of the entities disclosed in Baker, i.e., the service bureau or the individual accounting and tax preparation firms, can be considered to be a “tax data provider” as recited in at least claim 1 and/or one of the types of tax data providers expressly recited in at least claims 6, 38, 40, 43, 46, and 49.

Based on the preceding arguments, the Applicant respectfully submits that at least claims 1, 11, 13, 42, 45, and 48 are not anticipated by Baker. Likewise, claims 6, 38, 40, 43, 46, and 49 are not anticipated by Baker. Claims 2-5, 7, 35-37, 39, 41, 44, 47, and 50 depend variously from claims 1, 11, 13, 42, 45, and 48 and are submitted as being allowable for at least the same reasons. Reconsideration and withdrawal of the rejections are respectfully requested.

### **III. CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

In numbered paragraphs 6-7 on pages 14-17 of the Office Action, claims 3, 6, 38, 40, 43, 46, and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker in view of Official Notice taken by the Office. By this Amendment, claims 6, 38, 40, 43, 46, and 49 are amended to more particularly define the recited “tax data provider.” Nonetheless, the subject matter recited in claims 6, 38, 40, 43, 46, and 49 is submitted as being allowable over Baker for at least the reasons set forth in Section II above. Moreover, **the Office’s taking of Official Notice is not believed to remedy such deficiencies**. Therefore, the Office Action also fails to establish a *prima facie* case of obviousness with regard to these features. Claim 3 depends from amended claim 1 (discussed above) and is, therefore, submitted as being allowable for at least the same reasons presented above. Reconsideration is respectfully requested based on the following comments.

Notwithstanding the Office’s clarification of those features upon which Official Notice has been taken (*see* page 7, line 15 – page 9, line 14), the Applicant respectfully maintains that the Office’s taking of Official Notice is inadequate, at least *in terms of remedying the deficiencies in Baker*. Claim 1, for example, recites “said electronic tax return and/or tax data is ***electronically provided*** to said electronic intermediary ***by a tax data provider***,” and claim 6 expressly provides specific types of such “tax data provider.” Based on the arguments set forth above in Section II(B), the individual accounting and tax preparation firms disclosed in Baker

are not “tax data providers,” nor do they fall within the scope of any of the expressly recited “tax data providers,” including a “taxing authority.” Moreover, the express recitations of “tax data provider,” as well as the specific types of such “tax data providers,” are not non-functional descriptive material. The Official Notice taken in the Office Action, thus, also fails to teach these features. The Office states “that it is old and well-known in the art of tax preparation to utilize tax data received from an employer, a partnership, a bank, a savings and loan institution, a mortgage institution, a credit card bureau, a thrift institution, a securities brokerage firm, a mutual fund holding institution, a charity, the IRS, or a taxing authority to complete one’s tax paperwork (e.g., tax returns).” Office Action, page 15, lines 16-20. Even assuming, *arguendo*, that this is true, the Office Action improperly seizes on this purportedly well-known teaching to jump to the conclusion that “it would have been obvious to one having ordinary skill in the art at the time of Applicant’s invention to modify Baker to receive tax data from [any one of the above-referenced parties] in order to expand the type of details made available through the data warehouse, thereby increasing the potential of interest in and marketability of the type of data stored in the data warehouse.” See Office Action, page 15, line 21 – page 16, line 5.

The Applicant respectfully submits that this conclusion is unsupported by the teachings of Baker as well as by the Officially Noticed facts. As set forth in Applicant’s previous response (*see* Amendment filed June 29, 2006, pages 14-15), even if it is considered well-known to utilize tax data received from one of the recited types of “tax data providers” to complete one’s own tax returns, the Applicant respectfully submits that it is not well-known in the art for a “tax data provider,” for example one of the expressly recited “tax data providers,” to **electronically provide** an electronic tax return and/or tax data to a tax information requestor via an electronic intermediary, or, alternatively, directly to a tax information requestor. Both Baker and the Official Notice, therefore, fail to address this recitation and the statement of obviousness in the Office Action amounts to an unsupported statement of conclusion. Thus, at least claim 6, for example, is allowable over Baker and the Official Notice.

In addition, Baker teaches away from the modification proposed by the Office. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. § 2143.01(VI). At page 15, line 21 – page 16, line 5, the Office Action states that it would have been obvious to modify Baker to receive tax

data from one of the recited tax data providers, rather than from individual accounting and tax preparation firms, “in order to expand the type of details made available through the data warehouse, thereby increasing the potential of interest in and marketability of the type of data stored in the data warehouse.” The Applicant respectfully disagrees and submits that such modification would not have been obvious in view of the teachings of Baker and the Official Notice. Baker is clear in teaching that the tax information is only provided by individual accounting and tax preparation firms and that “[t]his represents a *very material difference* from all prior art.” Baker, column 2, lines 33-38 (emphasis added). Thus, Baker does not contemplate such tax information being received from any other source such as, for example, the tax data providers recited in at least claims 1 and 6. Moreover, based on the foregoing statement, such modification would be contradictory to Baker’s core principle of operation. *See* Baker, column 5, lines 34-39. Accordingly, Baker teaches away from the modification proposed by the Office Action, and the Office has failed to set forth a *prima facie* case of obviousness.

In response to the arguments on this point at page 9, line 20 – page 10, line 2 of the Office Action, the Applicant respectfully reiterates that the express recitation of the specific types of tax data providers does, in fact, affect the structure and functionality of the claimed invention. *See* Section II(B) above. Moreover, the Office’s position that “Baker’s principle of operation would not be affected since its existing structure and functionality can clearly perform at least the basic functions of the claimed invention” (page 10, lines 1-2) is improper because such position effectively distills the claims down to a “gist” or “thrust” of the invention and, therefore, fails to afford the necessary patentable weight to the recitation of the specific tax data provider types.

Based on the preceding arguments, the Applicant respectfully submits that at least claims 3, 6, 38, 40, 43, 46, and 49 are not unpatentable over Baker. Reconsideration and withdrawal of the rejections are respectfully requested.

#### IV. CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and

complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

It is not believed that extensions of time or other fees are required beyond those that may otherwise be provided for in documents accompanying this paper. If, however, additional extensions of time are needed to prevent abandonment of this application, such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims or any other fee deficiency), are hereby authorized to be charged, and any overpayments credited to, our Deposit Account No. 22-0261.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Dated: 1/22/07

Respectfully submitted,

By 

Michael A. Sartori, Ph.D.

Registration No.: 41,289

Ryan M. Flandro

Registration No.: 58,094

VENABLE LLP

P.O. Box 34385

Washington, DC 20043-9998

(202) 344-4000

(202) 344-8300 (Fax)

Attorney/Agent For Applicant